



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/871,112	05/31/2001	John S. LeFevre	035451-0129 (3631.Palm)	9793

26371 7590 08/11/2004  
FOLEY & LARDNER  
777 EAST WISCONSIN AVENUE  
SUITE 3800  
MILWAUKEE, WI 53202-5308

EXAMINER

DALENCOURT, YVES

ART UNIT PAPER NUMBER

2157

DATE MAILED: 08/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/871,112

Applicant(s)

LEFEVRE ET AL.

Examiner

Yves Dalencourt

Art Unit

2157

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 31 May 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 1-9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 3.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

This office action is responsive to communication filed on 05/31/2001.

#### ***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

Group I. Claims 1 - 9, drawn to a handheld computer, classified in class 707, subclass 174.

Group II. Claims 10 - 20, drawn to a method of using an e-mail application in a wireless environment, classified in class 709, subclass 206.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the e-mail application does not have to be used in a handheld computer per se. The subcombination has separate utility such as being used in a wired environment (desktop computer) instead of in a wireless environment.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

During a telephone conversation with Mr. Alistair K. Chan on July 14, 2004 a provisional election was made without traverse to prosecute the invention of group II, claims 10 - 20. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1- 9 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### ***Specification***

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The

Art Unit: 2157

disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

Therefore, " is disclosed " (page 18, line 2) is implied and should be avoided.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

The term "desired manner" in (claim 15, lines 3 and 4) is a relative term which renders the claim indefinite. The term "desired manner" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. In fact, what is considered today as a **desired manner** to do something, could be different in the future.

Claims 16 – 20 are necessarily rejected as being dependent upon the rejection of claim 15.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 17 – 19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to

which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Regarding claims 17 –19, the limitations of “ wherein the modifications to the parameters of the handheld computer includes removing operating system incompatibilities with the software application (claim 17); wherein the modifications to the parameters of the handheld computer includes removing hardware incompatibilities with the software application (claim 18); wherein the modifications to the parameters of the handheld computer includes removing display incompatibilities with the software application (claim 19) “ are not described in the specification. Applicants disclose that when a user selects the icon of the launching application, the launching application functions to provide the necessary functionality such that the software ..... on handheld computer 100 (see paragraph 0020). It has not been disclosed how the limitations in claims 17 – 19 are taken place. Therefore, one skilled in the art would not know how to make and/or use the invention.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 10 – 15 and 17 – 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Chandrasekhar Narayanaswami (US 6,678,535; hereinafter Narayanaswami).

Regarding claims 10 and 15, Narayanaswami teaches a method of using an e-mail application in a wireless environment (314, fig. 4), which comprises the steps of providing an e-mail application not configured for use over a wireless connection on a handheld computer (col. 10, lines 9 – 12; Narayanaswami discloses a smart pervasive dock protocol adapter 500 equipped with a content transcoder device 530 for transcoding received data on the fly, such as a huge e-mail message that is eventually destined to be received by the Wrist Watch); providing a launching application on a handheld computer, the launching application displaying an icon on the handheld computer representative of the e-mail application (icon 314, fig. 4; col. 7, lines 17 – 20); starting the launching application (col. 7, lines 23 – 25); modifying parameters of the handheld computer, by the launching application, so that the e-mail application is able to use a wireless connection (see paragraph bridging col. 6, line 64 through col. 7, line 8; col. 10, lines 12 – 23; Narayanaswami discloses, however, a transcoder device software that converts the web page into a format more suitable for viewing on the smaller handheld device, e.g. by converting color images to gray scale images or changing the resolution of the images so that they fit on the smaller device. The transcoder device of the smart pervasive dock protocol adapter device will be notified of the characteristics of the communicating input and output devices so that additional optimizations/conversions may be performed); and running, automatically, the e-mail

Art Unit: 2157

application (paragraph bridging col. 4, line 63 through col. 5, line 8; Narayanaswami discloses an icon 314 on the system display to launch an e-mail application; once such icon is selected, the e-mail application would run automatically).

Regarding claim 11, Narayanaswami further teaches the step of connecting wirelessly to an e-mail server (fig. 3; col. 3, lines 28 – 34; col. 6, lines 35 - 39).

Regarding claim 12, Narayanaswami further teaches the step of sending an e-mail to the e-mail server (col. 6, lines 41 – 44; Narayanaswami discloses a user interface manager 255 processing events received from user input devices such as a touch panel for the appropriate applications).

Regarding claim 13, Narayanaswami teaches that the handheld computer includes a radio frequency transceiver (col. 4, lines 2 – 7 and lines 53 - 62).

Regarding claim 14, Narayanaswami teaches that the launching application started by selecting the icon representative of the e-mail application (col. 7, lines 17 - 25).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of



the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chandrasekhar Narayanaswami (US 6,678,535; hereinafter Narayanaswami).

Regarding claim 16, Narayanaswami teaches a method of using an e-mail application in a wireless environment, wherein the application supported is the microbrowser which enables access to a WAP supporting Web-based communications written in, for example, the Wireless Markup Language (WML) using the XML standard (see col. 7, lines 1 – 8), but fails to explicitly teach that such application is a web clipping application.

However, one skilled in the art recognizes that substituting the microbrowser which enables access to a WAP supporting Web-based communications written in, for example, the Wireless Markup Language (WML) using the XML standard for the web clipping application as claimed would be within the level skilled of an artisan in the art.

Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute a microbrowser for a web clipping application as claimed, since both are data applications and protocols that allow users to browse the Internet on small device screens, for the purpose of providing a user friendly and

convenient navigation of displayed information in a handheld device, so that a large amount of data can be viewed in the relatively small size of the display's device.

**Claims 17 – 19 are rejected with art as best understood by the examiner based on the description of the launching application functions in regards to the modification methods (see specification, paragraph 0020).**

Regarding claim 17, Narayanaswami teaches a method of using an e-mail application in a wireless environment, wherein the modifications to the parameters of the handheld computer includes removing operating system incompatibilities with the software application (see fig. 8a; col. 7, lines 17 – 25; col. 11, lines 8 – 39; Narayanaswami discloses an icon 314 for launching an application directed to retrieving/storing/displaying e-mail messages, which will make necessary modifications to the software operating system in order to be compatible with the Wrist Watch device).

Regarding claim 18, Narayanaswami teaches a method of using an e-mail application in a wireless environment, wherein the modifications to the parameters of the handheld computer includes removing hardware incompatibilities with the software application (see fig. 8a; col. 7, lines 17 – 25; col. 11, lines 8 – 39; Narayanaswami discloses an icon 314 for launching an application directed to retrieving/storing/displaying e-mail messages, which will make necessary modifications to the hardware devices in order to be compatible with the Wrist Watch device).

Regarding claim 19, Narayanaswami teaches a method of using an e-mail application in a wireless environment, wherein the modifications to the parameters of the handheld computer includes removing display incompatibilities with the software

application (see fig. 8a; col. 7, lines 17 – 25; col. 11, lines 8 – 39; Narayanaswami discloses an icon 314 for launching an application directed to retrieving/storing/displaying e-mail messages, which will make necessary modifications to the software operating system in order to be compatible with the Wrist Watch device).

Regarding claim 20, Narayanaswami teaches a method of using an e-mail application in a wireless environment, which further comprises the step of selecting the icon of the launching application (figs. 4 and 5; col. 7, lines 17 - 58).

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Marianetti et al (US 6,539,476) discloses a mobile computer system capable for copying set-up application including removal routine from peripheral device for removing device programs after the device is removed.

Burg et al (US 6,362,840) discloses a method and system for graphic display link actions.

David Y. Feinstein (US 6,466,198) discloses a view navigation and magnification of a hand-held with a display.


### Contact Information


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yves Dalencourt whose telephone number is (703) 308-8547. The examiner can normally be reached on M-TH 7:30AM - 6: 30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (703) 308-7562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Yves Dalencourt

  
July 23, 2004

  
ARIO ETIENNE  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100